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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,318	10/26/2001	Ching-Chung Huang	DEE-PT037	3396

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EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 06/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N

10/001,318

Applicant(s)

HUANG, CHING-CHUNG

Examiner

José A Fortuna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6, 20 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 6 and 28, there is nothing in the specification that guides one of ordinary skill in the art as to how to make the determination of dosage and coating, without an un-due experimentation. As to Claim 20, there is nothing in the specification that teaches and/or guide to one of ordinary skill in the art how to make use of the invention for the different uses as claimed, specially for temperature control devices, and hot water pipes and light control.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is vague and indefinite as what are "biodegradable plant fibers." Claim 6 is vague and indefinite as how the dosage is obtained. The specification does not give any information as to how this is done. Claim 7 is vague and indefinite since it claims inorganic and organic packing materials, however in the Markush group only inorganic materials are recited. Claims 13 is vague and indefinite as to the meaning of "up" preceding "150" and "300" in the second and

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fourth lines of the claim. Claim 19 is vague and indefinite since it is unclear how is the paper directly obtained from a waste cardboard. Should it be that the fibers or the pulp or the papermaking material is obtained from waste cardboard?" Claim 28 is vague and indefinite as how the dosage is obtained. The specification does not give any information as to how this is done. Claim 32 is vague and indefinite as to what are "seeds of economical plants?" Claim 33 is vague and indefinite as to how the uneven structure is made? i.e., how are the parameters for making the structure based in the requirements of a specific crop. The specification does not give any information as to how this is done.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-20 are rejected under 35 U.S.C. 102(b)/102(e) as being anticipated by

Bartelloni, US Patent No. 4,510,019 or Hoffman, US Patent No. 5,061,345, or Watson et al., US Patent No. 6,447,640, (102(e)) and Reiner et al., US Patent No. 6,344,110, 102(e).

Regarding claims 1-20, all of the above patents, Bartelloni, Hoffman, Watson et al. and Reiner, teach a method of making paper in which a paper pulp is cleaned a functional additive is then added and the paper is processed to form a uneven surface, see abstract. The use of waste paper, biodegradable plant fibers¹ and polymers is shown by all the references, see Watson et al., column 3, lines 48-56; Hoffman, abstract; Bartelloni column 6, lines 16-28 and Reiner et al. in

¹ Biodegradable plant fiber has been interpreted as any fibers from a plant source, e.g. wood, bagasse, pea moss, etc.

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column 4, lines 18-48 The uneven surface is taught by Bartelloni, in the embossing of example IV-4; Watson et al., embossing in the abstract, by the use of an impression fabric; Hoffman in column 6, line 21 in the use of the sheet in corrugated containers; and Reiner et al. in the embossing by configured rolls, see abstract. Hoffman teaches the steps as claimed in claim 3 and the pH of the paper as claimed in claim 12, see column 4, lines 60-65 and column 5, line 34 through column 6, line 25. Hoffman also teaches in same lines that the properties of the paper as claimed in claims 14-17. Note also that all of the above references teach the addition of calcium carbonate as filler and wet strength or dry strength agents. Note that references read over claim 5, because the rejection is based in the use of then other compounds, i.e., calcium carbonate and wet and dry strength agents. As to the use of the paper of claims 19 and 20, the paper of the claimed references can be inherently used in any of the applications as claimed.

6. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Holloway, US Patent No. 6,446,386.

Holloway teaches a seed germination medium comprising an upper layer formed from a biodegradable material and a lower layer formed from biodegradable material. The Layers are formed by conventional papermaking operation, either wet or air laid, see column 3, lines 12-28. Holloway teaches also the use of additives in the layers, such as fertilizers, pesticides, wet and dry strength agents, column 4, line 60 through column 5, line 28. Holloway teaches also the punching of holes/perforations to insert the seeds and the distribution/density of those holes, see column 2, lines 39-41 and column 3, lines 47-67. Holloway teaches also the grammage of the layers/paper within the claimed range and shows the unevenness of the surface(s) in the figures, see figures 2, 7-9.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Multi-use papers."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A Fortuna whose telephone number is 703-305-7498. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7115 for regular communications and 703-305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0662.


José A Fortuna
Primary Examiner
Art Unit 1731

JAF
June 15, 2003
